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EXAMINER

NGUYEN, CUONG H

ART UNIT PAPER NUMBER

3625

DATE MAILED: 05/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/776,188

Applicant(s)

ZIMMERMAN ET AL.

Examiner

CUONG H. NGUYEN

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MLW

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Status of the claims

1. The Request for Reconsideration and the Request for Changing the address received on 2/18/2004 are entered. Claims 1-17 are pending.

Priority

2. This application is a CIP of prior Application No. 09/455,145, filed 12/06/1999, and claims the benefit of U.S. Provisional Application # 60/182,624, filed 2/15/2000.

Drawings

3. The formal drawings (7 sheets with 7 figures) filed on 2/03/2001 are accepted by the examiner.

Response

4. The submitted arguments on 2/18/2004 are unpersuasive. Arjomand clearly teaches about a response by wireless communication from a vehicle's equipment when receiving a remote command (see Arjomand, the abstract) based on the examiner's broadest reasonable interpretation of the language of pending claim 1 (see *In re Pearson*, 181 USPQ 641 (CCPA 1974)) - the examiner respectfully submits that "A claim is anticipated only if each and every element is found in a single prior art reference" has been followed for this examination.

A. In the argument on page 2 last para., and on page 4, para. 1-2, 4 (paper received on 2/18/2004), the applicants argue that

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Arjomand does not initiate a wireless communication in response to any diagnostic message - the examiner submits that this argument is not correct (see Arjomand, the abstract - Arjomand teaches about receives responses of diagnostic information on a remote display; therefore, a wireless communication between components MUST BE initiated - this is a fundamental fact to communicate between 2 parties; this was inherently included in Arjomand's response, although the term "initiate" was not used) - in a limitation of "initiating a wireless communication response to the diagnostic message, the wireless communication initiated by electronic equipment installed in the vehicle", Arjomand teaches that idea by showing "a response signal" when receiving a diagnostic command from Fig.8, refs.14, 16, 46.

B. For the argument on page 3, 1st para., the examiner submits that Arjomand teaches steps of receiving and sending of diagnostic commands from a vehicle via wireless communication.

C. For the argument on page 4, 2nd para., the examiner submits that Arjomand inherently teaches about initiating a wireless communication in response to a diagnostic message (see Arjomand, Fig. 8).

D. On page 5, 1st para. the applicants argue - Arjomand wholly fails to mention any type of "request" - the examiner submits that although this term was not used (because it is a

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fundamental fact), Arjomand inherently teaches about communication for vehicle's diagnostic test; therefore, all commands/requests are included in this wireless communication.

E. In page 6, 1st para. because Arjomand sufficiently teaches all limitations of claim 1, and Razavi et al. further teach a limitation of claim 2; therefore, it would have been obvious to one of ordinary skill in the art to combine Arjomand and Razavi et al. in adding information about a vehicle's location because artisan recognized that this information is clearly necessary in certain cases (e.g., for towing a disable vehicle).

F. For the argument on page 7, 3rd para., the examiner takes the Official Notice because the claimed limitation is old and well-known. Claiming "requesting if an occupant of the vehicle would like the electronic equipment to initiate a wireless communication" is merely asking for a "Yes" or "No" answer for sending back a response after receiving a command/query.

Although not disclosing specifically, above particular request would easily be implemented in "USER INTERFACE MODULE 12" to ask if diagnostic results are reported automatically or a manually. Arjomand would suggest a person to control a USER INTERFACE MODULE 12 to perform exactly claimed function (see Arjomand, Figs. 6, 8).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 4-11, 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Arjomand (US Pat. 5,884,202).

A. As to claim 11: Arjomand teaches a method and a system of communicating a diagnostic message from a vehicle, comprising:

- detecting the diagnostic message (see **Arjomand**, Fig.1, ref. 16, Fig.8 ref.12, and 1:5-30);
- Arjomand inherently requests to initiate a wireless communication in response to the diagnostic message - this has been known as "a hand-shaking procedure" (see **Arjomand**, Fig.1, ref. 16, 1:21-30, 3:22-46; and Fig.8, ref. 14); and
- initiating the wireless communication, the wireless communication initiated by electronic equipment installed in the vehicle (see **Arjomand**, the abstract, 3:13-14, 4:8-10, Fig.3, and Fig.8, ref. 50).

- Therefore, Arjomand teaches all claimed steps that use above system.

B. As to claim 1: It comprises similar limitations as claim 11; therefore, similar rationales and reference set forth are applied for a 35 USC 102(b) rejection.

C. As to claim 14: Arjomand teaches a method of communicating a diagnostic message from a vehicle, further comprising communicating with an occupant of the vehicle to schedule an appointment for service (see **Arjomand**, the abstract, Fig.6, ref. 12, and 1:5-30, 1:30-37). In another word, Arjomand teaches that communication step before servicing a vehicle.

D. As to claims 5, 16: They comprise similar limitations as claim 14; therefore, similar rationales and reference set forth are applied for 35 USC 102(b) rejections.

E. As to claim 15: Arjomand teaches a method of communicating a diagnostic message from a vehicle.

Arjomand also teaches about initiating/commanding a wireless communication representing a diagnostic message from an electrical management system (see **Arjomand**, the abstract, Fig.8, ref. 16, and 1:5-30, 1:30-37). In another word, Arjomand teaches that claimed communication step using a user interface module (ref.12) and a VOM (ref.16).

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F. As to claim 4: It comprises similar limitations as claim 15; therefore, similar rationale and reference set forth are applied for a 35 USC 102(b) rejection.

G. As to claim 17: Arjomand teaches a method of communicating a diagnostic message from a vehicle, wherein initiating a wireless communication comprises commanding a device to transmit a wireless communication through a user interface module, and a main control module to i.e., "control and obtain data by wireless communication", "executes diagnostic application programs and displays information to the user" (see **Arjomand**, the abstract, Figs.6, 8, and 1:5-37).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this

Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arjomand (US Pat. 5,884,202) as applied to claim 1 above, and further in view of Razavi et al. (US Pat. 6,362,720).

Arjomand teaches a method of communicating a diagnostic message from a vehicle. Arjomand does not disclose that initiating a wireless communication representing the vehicle's location.

However, Razavi et al. disclose that information for wireless communication includes a vehicle's location (See **Razavi** et al., the abstract).

It would have been obvious to one of ordinary skill in the art to combine Arjomand with Razavi et al. in adding information about a vehicle's location because artisan recognized that this information is clearly necessary in certain case (e.g., for towing a disable vehicle).

6. As to claims 6-10: They are rejected under 35 U.S.C. 103(a) as being unpatentable over Arjomand (US Pat. 5,884,202).

These claims comprise similar limitations as claim 17; therefore, similar rationales and reference set forth for a rejection of claim 17 are applied for 35 USC 103(a) rejections.

7. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Arjomand (US Pat. 5,884,202) as applied to claim 11 above, in view of the Official Notice.

Arjomand teaches a method of communicating a diagnostic message from a vehicle.

Arjomand does not disclose that requesting if an occupant of the vehicle would like the electronic equipment to initiate the wireless communication.

However, the Official Notice is taken here that requesting if an occupant of the vehicle would like the electronic equipment to initiate the wireless communication is an option that give the vehicle user a choice to select that option (e.g., if a cell-phone received a voice-mail message, it would give an audible sound to acknowledge a user to initiate an action of listening to that voice-mail or not; the act of initiating is performed analogously to what claimed).

It would have been obvious with one of ordinary skill in the art at the time of the invention to implement the Official Notice taken to Arjomand's teachings because having an option in initiating to a wireless communication device, for example, initiating an action/deciding to listen or not by pushing a button on a cell-phone is old and well-known by merely modifying available software to adding a decision step.

8. Claims 3, 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Arjomand (US Pat. 5,884,202) as applied to claim 11 above, in view of Phillips et al. (US Pat. 6,351,221)..

A. As to claim 13: Arjomand teaches a method of communicating a diagnostic message from a vehicle.

Arjomand does not disclose about notifying that a diagnostic message has been communicated.

However, Phillips et al. teach what Arjomand does not disclose (See **Phillips** et al., 1:28-55).

It would have been obvious with one of ordinary skill in the art at the time of invention to combine Arjomand and Phillips et al., because they are in the same field of endeavor, and because their teaching about notifying a communication is established would ensure that a diagnostic message is being transmitted and is received for a complete communication.

B. As to claim 3: It comprises similar limitations as claim 13; therefore, similar rationale and references set forth are applied for a 35 USC 103(a) rejection.

Conclusion

9. Claims 1-17 are not patentable.

10. THIS ACTION IS MADE FINAL, See MPEP § 706.07(a).

Applicants are reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Notes: In re Mraz, 59 CCPA, F.2d, 173 USPQ 25, 28 (1972), it says: "Claims which are broad enough to read on obvious subject matter are unpatentable even though they also read on nonobvious subject matter".

In re **Prater**, 162 USPQ 541 (CCPA 1969), the court rules: During patent examination, the pending claims must be given the broadest reasonable interpretation consistent with the specification. Reading a claim in light of the specification, to thereby interpret limitations explicitly recited in the claim, is quite different from reading limitations of the specification into a claim, to thereby narrow the scope of the claim by implicitly adding disclosed limitations which have no express basis in the claim.

For rejections on obviousness, the examiner submits that although those claims may be written with different languages, one of ordinary skill in the art at the time of the invention would have found claimed limitations very obvious with inherent

steps as suggested by cited prior art; prior art's limitations are not necessary spelled-out exactly claimed languages. Cited prior art is not limited to the described embodiments in Arjomand's invention. It is reasonable that flexible modifications/variations of the described method/system of the cited prior art would be apparent to those skilled in the art without departing from the scope and spirit of the invention. Although Arjomand's invention has been described in connection with specific preferred embodiments, it should be understood that his invention as claimed should not be limited to such specific embodiments.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to CUONG H. NGUYEN whose number is 703-305-4553. The examiner can normally be reached on 7am-3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, JEFFREY A. SMITH can be reached on 703-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-305-7687 or 703-746-5572.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Cuong H. Nguyen

CUONG H. NGUYEN
Primary Examiner
Art Unit 3625